REMARKS

Applicant wishes to thank the Examiner for the consideration given this case to date. Applicant has now had an opportunity to carefully consider the Examiner's action, and respectfully submits that the application is now in condition for allowance. As filed, claims 1-14 were pending. Claims 1-14 remain and are believed patentable over the rejections of record.

THE EXAMINER'S ACTION

In the Office Action dated February 13, 2004, the Examiner:

rejected claims 1-14 under 35 U.S.C. § 103(a) as being obvious in light of U.S. Patent No, 5,974,453 to Anderson et al ("Anderson '453").

REJECTIONS UNDER 35 U.S.C. § 103(a)

The Office has rejected claims 1–14 as being obvious in light of Anderson '453. Initially, Applicant notes that for an obviousness rejection the MPEP requires that the prior art must suggest the desirability of the claimed invention. MPEP 2143.01. It is well settled that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Id. It other words, there must be some objective reason to combine the teachings of the references. Id. Recently the Federal Circuit summarized the law in this area in In re Fulton, 2004 U.S. App. LEXIS 24815 (Fed. Cir., December 2, 2004). There the court noted that, "[s]tated another way, the prior art as a whole must 'suggest the desirability' of the combination. In re Beattie, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (internal quotation omitted); Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340 (Fed. Cir. 2000) ('Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter.'). The source of the teaching, suggestion, or motivation may be 'the nature of the problem,' 'the teachings of the pertinent references,' or 'the ordinary knowledge of those skilled in the art.' In re Rouffet, 149 F.3d at 1355." In re Fulton.

Here claim 1 calls for the plurality of domains corresponding to the telephone number portion to be "arranged in an order corresponding to the telephone numbered portion." The Office asserts that the claimed "order" could be met by Andersen '453's teaching of reversed telephone numbers (Andersen '453 teaches entered phone number 011-123-456-7890 being reserved to 7890.456.123.011 in observance of the convention that DNS names are resolved from right to left with the highest hierarchical or least specific portion of the name being furthest on the right). Alternatively, the Office baldly asserts that it would be obvious to place the number in conventional telephone number sequence or reversed as taught by Andersen '453. Both of these assertions do not withstand scrutiny.

As claimed, the "order" of the domains may not be arbitrarily varied to forward or reverse, as suggested by the Office. Instead, the order corresponds to the telephone number portion. In claim 1, the telephone number portion has antecedent basis as the received element that identifies a device. In other words, the telephone number portion is "ordered" as a telephone number. Thus, the suggestion by the Office that Andersen '453 teaches the claim limitations because a "reverse order is still an order" is incorrect.

In the alternative, the Office states without any support or basis, that it would be obvious to reverse the order of the domains taught by Andersen '453 back into an order corresponding to a telephone number. This rejection is improper for at least two reasons. First, the Office must supply a basis for making the modification. Obviousness requires "some objective reason to combine the teachings of the references." Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Second, Andersen '453 fails to suggest the desirability of the combination. Indeed, the standard recited in In re Fulton, noting that the motivation to combine requires that the proposed changes be desirable, as opposed to merely feasible, clarifies the shortcoming of the Office's position. Andersen '453 lists among the problems it sought to overcome the "inability to scale ...." (Column 1, line 49, 50). With this problem in mind, Andersen '453 notes in the Detailed Description that "[o]ne great advantage of this [described] system is that scaling is possible by further dividing the dir-con domain into further subdomains. For example, a hybrid DNS server may serve each area code...." (Column 5, line 33-36). Thus, since Andersen '453

6

fails to show or suggest that the modification proposed by the Office is desirable, the obviousness rejection is improper and should be withdrawn.

Claim 7, as amended, calls for receiving a multiple level domain name at least partially derived from a telephone number portion identifying a second device where the multiple level domain name is arranged in an order corresponding to that of the telephone number portion. Anderson '453 fails to teach or fairly suggest this. Indeed, Anderson '453 uses two identifiers arranged in reverse order from each other. First, Anderson '453 describes a "static identifier" that is illustrated as a phone number (see figure 4, reference 400). Second, this "static identifier" is then immediately reversed (see figure 4, reference 410) during the conversion to a DNS format. In other words, the DNS formatted "static identifier" no longer is ordered in correspondence with the "static identifier." Moreover, the Office cites no reference suggesting the desirability of the proposed modification, namely that the "static identifier" remain in its originally presented form. Because Andersen '453 does not teach the elements as claimed and, because no properly combinable reference has been presented, this rejection is believed overcome.

Claim 10 calls for an apparatus which <u>receives a telephone number portion</u> identifying a second device, and which converts the received telephone number portion into a static multiple level domain name identifying the second device on the network while <u>preserving sequencing of the telephone number portion</u>. The Office considered claim 10 in parallel with claim 1 despite the different claim language. For example, claim 10 lacks the "order" language of claim 1. Notwithstanding, the Office asserts that the claimed "order" could be met by Andersen '453's teaching of reversed telephone numbers (Andersen '453 teaches entered phone number 011-123-456-7890 being reserved to 7890.456.123.011 in observance of the convention that DNS names are resolved from right to left with the highest hierarchical or least specific portion of the name being furthest on the right). Alternatively, the Office asserts without any support that it would be obvious arrange the multiple level domain name in any order – forward as claimed or reversed as taught by Andersen '453. Both of these assertions do not withstand scrutiny.

Claim 10 recites receiving a telephone number portion and converting into a static multiple level domain that preserves the sequencing of the telephone number portion. The

7

argument that the telephone number portion may be sequenced in any order flies in the face of the claim language used. Specifically, as claimed, the telephone number portion is received in a certain sequence, and after conversion into a multiple level domain name, that sequence is preserved. Andersen '453, on the other hand, teaches no such continuity. First, Anderson '453 describes a choosing a "static identifier" that is illustrated as a phone number (see figure 4, reference 400). Second, this "static identifier" is then immediately reversed (see figure 4, reference 410) during the conversion to a DNS format. In other words, the sequencing of the "static identifier" is not preserved upon conversion to DNS format. The failure of the primary reference to teach or suggest the claimed invention renders this rejection improper.

In the alternative, the Office states without any support or basis, that it would be obvious to reverse the order of the domains taught by Andersen '453 back into an order corresponding to a telephone number. This rejection is improper for at least two reasons. First, the Office must supply a basis for making the modification. Obviousness requires "some objective reason to combine the teachings of the references." Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Second, Andersen '453 fails to suggest the desirability of the combination. Indeed, the standard recited in In re Fulton, noting that the motivation to combine requires that the proposed changes be desirable, as opposed to merely feasible, clarifies the shortcoming of the Office's position. Andersen '453 lists among the problems it sought to overcome the "inability to scale ...." (Column 1, line 49, 50). With this problem in mind, Andersen '453 notes in the Detailed Description that "[o]ne great advantage of this [described] system is that scaling is possible by further dividing the dir-con domain into further subdomains. For example, a hybrid DNS server may serve each area code...." (Column 5, line 33-36). Thus, since Andersen '453 fails to show or suggest that the modification proposed by the Office is desirable, the obviousness rejection is improper and should be withdrawn.

CONCLUSION

For the foregoing reasons, Applicant respectfully asserts that the case is now in a condition for allowance. While no additional fees are believed due, the Commissioner is hereby authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 02-2051, referencing Attorney Docket No. 26769-6.

Respectfully submitted,

Dated: December 27, 2004   By: _____
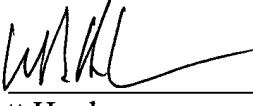
W. Scott Harders
Registration No. 42,629

BENESCH, FRIEDLANDER,
 COPLAN & ARONOFF, LLP
2300 BP Tower
200 Public Square
Cleveland, OH 44114-2378
(216) 363-4443

9